

TRAVERSE

Applicants respectfully request reconsideration and withdrawal of the requirement for restriction at least for the following reasons. In addition, if the current restriction requirement were to be maintained and made final, Applicants request that this paper be considered a petition to the Direction under 37 CFR §1.144, based upon the following reasons.

Reason 1 for Withdrawal of the Restriction Requirement

The restriction requirement, which follows an Office action issued on May 18, 2005 on the merits of all of the original claims 1-8, requires restriction from among the following three inventions:

- Invention I : Claims 1-13, directed to an article of footwear with a flexible upper, tightening arrangement on the upper, a heel stiffener with lateral walls with a recess in each lateral wall and a strap affixed to the recess ...;
- Invention II : Claims 14-16, directed to an article of footwear with a tightening arrangement provided on the upper, a molded heel stiffener with lateral walls and a base and an outer sole attached to the base;
- Invention III : Claims 17-20, directed to an article of footwear with a flexible upper, a tightening arrangement on the upper, a molded heel stiffener with upstanding lateral walls with a notch located between the lateral walls and an outer sole beneath the lateral walls ...”

Each of the Inventions I, II, III includes an independent claim, *viz.*, claims 1, 14, and 17, respectively, each of which includes the subject matter referenced in the descriptions of the three inventions.

The Office action of May 18, 2005 included an action on the merits of the subject matter of all three of the inventions. Specifically, the subject matter of the “article of

footwear with a flexible upper, tightening arrangement on the upper, a heel stiffener with lateral walls with a recess in each lateral wall and a strap affixed to the recess," i.e., the subject matter of Invention I, appeared in original claim 3 (which dependent claim incorporates therein the subject matter of parent claim 1 and that of intervening claim 2). Further, the subject matter of the "article of footwear with a tightening arrangement provided on the upper, a molded heel stiffener with lateral walls and a base and an outer sole attached to the base," i.e., the subject matter of Invention II (which additionally includes sole portions of different thicknesses), appeared in original claim 7 (which dependent claim incorporates therein the subject matter of parent claim 1). Lastly, the subject matter of the "article of footwear with a flexible upper, a tightening arrangement on the upper, a molded heel stiffener with upstanding lateral walls with a notch located between the lateral walls and an outer sole beneath the lateral walls," i.e., the subject matter of Invention III, appeared in original claim 4 (which dependent claim incorporates therein the subject matter of parent claim 1 and that of intervening claims 2 and 3).

Because an Office action on the merits has been issued, Applicants respectfully submit that the "serious burden on the examiner" criterion cited in MPEP §803.01 has not been met for requiring restriction. Accordingly, reconsideration and withdrawal is requested for this reason.

As an incidental matter, Applicants note from the record that appears in the U.S. Patent and Trademark Office's PAIR database for the instant application, that the following subclasses of class 36 had been searched on May 6, 2005, prior to the mailing of the aforementioned Office action on the merits: 7.1A, 24.5, 68, 69, 73, 76HH, 87, 92, 104, and 149.

If the invention of claims 17-20 is properly classified in class 36, subclass 102, as set forth in the restriction requirement, Applicants kindly request that subclass 102 be searched, as well.

Reason 2 for Withdrawal of the Restriction Requirement

Applicants respectfully submit that the reasons presented in the restriction requirement for insisting upon restriction are in error and, therefore, for this additional reason, reconsideration and withdrawal of the restriction requirement is requested for this additional reason.

The second criterion cited in MPEP §803.01 for restriction is that the inventions must be independent or distinct. For the latter, relied upon in the instant case, MPEP §806.05-806.05(i) are cited. The restriction requirement in the instant case relies upon MPEP §806.05(d) – see Section 2, on page 2 of the Office action. More specifically, in the instant case, restriction is required on the ground that “Inventions I, II and III are related as subcombinations disclosed as usable together in a single combination.”

Applicants respectfully disagree. Each of independent claims 1, 14, and 17 is directed to an “article of footwear.” MPEP §806.05(a) explains that “[a] combination is an organization of which a subcombination or element is a part.” Applicants submit that an article of footwear, at least in the context of Applicants’ disclosure, if not generally, might be regarded a “combination,” but not a “subcombination.” If the latter were to be alleged, as in the instant case, Applicants would question the identity of the “organization” of which the articles of footwear of each of the alleged subcombinations were to be regarded as a “part.” Applicants submit that there is no such organization and, therefore, identifying Inventions I, II, and III as “subcombinations” is in error.

Rather than claiming three subcombinations, Applicants have claimed, in claims 1, 14, and 17, an article of footwear which “are but different definitions of the same disclosed subject matter, varying in breadth or scope of definition,” in which case, as explained in MPEP §806.03, “restriction therebetween should never be required.

SUMMARY AND CONCLUSION

For the reasons presented above, reconsideration and withdrawal of the restriction requirement is kindly requested.

No fee is believed to be due at this time. However, the Commissioner is authorized to charge any fee required for acceptance of this reply as timely and/or complete to Deposit Account No. 19-0089.

Further, although no extension of time is believed to be necessary at this time, if it were to be found that an extension of time were necessary to render this reply timely and/or complete, Applicants request an extension of time under 37 CFR §1.136(a) in the necessary increment(s) of month(s) to render this reply timely and/or complete and the Commissioner is authorized to charge any necessary extension of time fee under 37 CFR §1.17 to Deposit Account No. 19-0089.

Any comments or questions concerning this application can be directed to the undersigned at the telephone or fax number given below.

Respectfully submitted,
Yves FARYS et al.



James L. Rowland
Reg. No. 32,674

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GREENBLUM & BERNSTEIN, P.L.C.
1950 Roland Clarke Place
Reston, VA 20191

(703) 716-1191 (telephone)
(703) 716-1180 (fax)